


RECEIVED
CENTRAL FAX CENTER
BEST AVAILABLE COPY

OCT 05 2005

I hereby certify that this correspondence is being transmitted via facsimile no. 571-273-8300 to Examiner Michael S. Chambers at the U.S. Patent and Trademark Office on the date indicated below.


Jean A. Jordan

Date 10-5-05IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor: Nick J. Rondinelli

Art Unit: 3711

Serial No. 10/694,320

Examiner: Michael S. Chambers

Filed: October 27, 2003

Confirmation No.: 3843

For: *Method and Apparatus for Playing a Combination Football/Basketball Game*

Attorney Docket: 648.001

Customer No.: 23598

AMENDMENT

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Office Action dated July 6, 2005, please amend the above-identified application as follows.

Amendments to the claims are reflected on the listing of claims which begins on page 2 of this paper.

Remarks begin on page 6 of this paper.

10/07/2005 YPOLITE1 00000032 501170 10694320
01 FC:2202 25.00 DA

(00084694.DOC /)

Serial No. 10/694,320 - Rondinelli
Art Unit 3711 - Attorney Docket 648.001
Response to July 6, 2005 Office Action
Page 7 of 7

BEST AVAILABLE COPY

basketball rules" is as definite as can be made. By requiring the applicant to further limit or define what is meant by these limitations in applicant's opinion would unduly limit the scope of the claims as it would require applicant to specify a particular version of the rules for American football and basketball.

Furthermore, applicant also believes the changing of various rules with regard to both American football and basketball is a well known aspect of each sport, such that the fact that the rules may be modified at a later date does not render claims 1-15 indefinite. In addition, the Examiner's statement in the Office Action regarding the fact that a broad term that may be modified at a later date in a claim as a limitation to identify or describe a particular material or product does not comply with Section 112, second paragraph, is limited to materials or products, and not to limitations such as rules for a sport which regularly change in a well known manner.

For these reasons, applicant respectfully requests that the Examiner withdraw the rejections to claims 1-15 because, in applicant's opinion, the subject matter of claims 1-15 is definite and allowable.

2. New Claim 22

In addition, with this response, applicant has added new claim 22 to the application. Claim 22 is an independent claim similar in scope to claim 1 but in which the limitations utilized as the basis for the indefiniteness rejection by the Examiner have been removed. Thus, while applicant believes that the subject matter of claim 1 is definite and allowable as written, should the Examiner maintain the indefiniteness rejections stated in the Office Action, because claim 22 is similar in scope to claim 1, but with these limitations removed, claim 22 is also considered to be allowable.

CONCLUSION

It is submitted that claims 1-15 and 22 are in compliance with 35 U.S.C. §112 and each define patentable subject matter. A Notice of Allowance is therefore respectfully requested.

A check in the amount of \$25 in payment of the fee by a small entity for submission of one additional claim over twenty is enclosed. Authorization is given to charge any additional

The PTO did not receive the following
listed item(s) Check \$25.00

{00084694.DOC /}

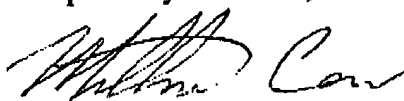
BEST AVAILABLE COPY

Serial No. 10/694,320 - Rondinelli
Art Unit 3711 - Attorney Docket 648.001
Response to July 6, 2005 Office Action
Page 8 of 8

fees or credit any overpayment in connection with this or any future communication to Deposit
Account No. 50-1170.

The Examiner is invited to contact the undersigned by telephone if it would help expedite
the prosecution and allowance of this application.

Respectively submitted,



Mathew E. Corr
Reg. No. 45,434

Date:

10/5/05

Customer Account No.: 23598

Boyle, Fredrickson, Newholm,
Stein & Gratz, S.C.
250 Plaza Building, Suite 1030
250 East Wisconsin Avenue
Milwaukee, WI 53202
Telephone: (414) 225-9755
Facsimile: (414) 225-9753
Email: mec@boylefred.com

{00084694.DOC /}